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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/180,209	12/22/1999	MIHAIL N. KARPUSAS	B189	6529

7590 01/27/2005

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EXAMINER

MORAN, MARJORIE A

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/180,209

Applicant(s)

KARPUSAS ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39,42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1631

All rejections and objections not reiterated below are hereby withdrawn.

Claims 39 and 42-43 are pending.

Information Disclosure Statement

The IDS filed 10/28/04 has been considered in full. The reference by LESK at al. was previously made of record, and has been crossed out to avoid duplication upon printing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors.

In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over MANDEL et al. (US 6,703,486)

MANDEL teaches a computer for producing a three dimensional representation of binding and active sites of a protein (Fig. 12 and col. 3, lines 39-47). MANDEL teaches that his computer may comprise a variety of programs for 3D modeling based on atomic or X-ray coordinates (col. 25, line 27-col. 26, line 25), teaches that his data may be carried on computer-readable media (col. 23, lines 25-40), and teaches a monitor for displaying results (col. 25, lines 16-18).

The crystal coordinates recited in the claims do not functionally interact with the computer or the program stored therein; i.e. neither the computer nor the program is structurally or functionally changed by the coordinates, therefore the coordinates are nonfunctional descriptive material. See also the definition set forth in MPEP 2106, set forth in the previous office action. It is noted that where a claim recites nonfunctional descriptive material which is not functionally related to the substrate on which it is stored, the nonfunctional descriptive material is considered, but is not entitled to patentable weight; i.e. as the structure coordinates do not functionally interact with the computer claimed, they are nonfunctional descriptive material, and therefore do not distinguish the claimed invention from the prior art of MANDEL.

With regard to analysis under 35 USC 103, MPEP 2106.VI states:

“Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217

Art Unit: 1631

USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or**

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention."**

Applicant's arguments filed 10/28/04 with respect to claims 39 AND 42-43 have been considered but are moot in view of the new ground(s) of rejection. In response to arguments with regard to *in re Gulack*, it is noted that the device claimed in the *Gulack* case is one wherein the data configuration (order of numbers on a band) is physically integrated with the claimed device, such that when the substrate upon which the data is recorded moves, the relationship of the data to the overall structure changes; i.e. a change in the data configuration inherently causes a physical/structural change in the claimed device. Contrary to

Art Unit: 1631

applicant's arguments, the same is not true of the instantly claimed computer. A change in the data configuration from one set of atomic coordinates to another does not cause any structural or physical change in the computer itself. For these reasons, the examiner maintains that the structure coordinates of the instant claims are nonfunctional descriptive material.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon. to Wed, 7:30-4; Thurs 7:30-6; Fri 7-1 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran
Primary Examiner
Art Unit 1631

Marjorie A. Moran
1/24/05